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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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8007

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EXAMINER

WORJLOH, JALATEE

ART UNIT

PAPER NUMBER

3685

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/336,741	<b>Applicant(s)</b> MA, SHERMAN CHING	
	<b>Examiner</b> Jalatee Worjloh	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-34 and 49-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-34 and 49-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4-28-2009</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 15, 2009 has been entered.
2. Claims 28-34 and 49-62 are pending.

### ***Response to Arguments***

3. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 32-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.<sup>2</sup> If neither

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<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

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of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, the claim(s) fail prong (1) because the method steps are not tied to a machine. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 62 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, it is unclear what device is implementing steps a) – h). Please clarify within the body of the claims.

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***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 28-30, 32-34, 50, 53-55, 57, 58, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5940812 to Tengal et al. ("Tengal") in view of US Patent No. 7437343 to Josephson et al. ("Josephson").

Referring to claim 28, Tengal discloses a computer memory and processor for executing instruction for: collecting at least two sets of decision criteria from at least two application recipients, each set comprising one or more decision criteria, and each decision criterion having a respective value, boundary or range, generating a superset of decision criteria, storing or accessing the superset of decision criteria (see abstract, col. 7, lines 20-39, and col. 11, lines 39-48), presenting the applicant with application information constituting the application for the two or more of the plurality of application recipients, said application information being requested by queries associated with said superset of decision criteria for the two or more of the plurality of application recipients (see fig. 5), receiving the application information (see fig. 1), accessing said decision criteria of said application recipients (see abstract), accessing said application according to said decision criteria of each of said application recipients (see abstract, fig. 2A) and forming a respective separate assessment of said application for each of said application recipients, each respective separate assessment being an approval or a rejection of the application (Fig. 2A, 2B col. 9, lines 22-26). Tengal does not expressly disclose determining respective

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unions of the values, boundaries or ranges of respective same decision criterion present in the at least two sets of decision criteria by analyzing the data value, boundary or range boundary requirements of each same decision criteria in the at least two sets of decision criteria, generating a superset of decision criteria which comprises at least one decision criterion from the at least two sets of decision criteria with the determined respective union of values, boundary or ranges. Josephson discloses the missing elements (see claims 1 and 2). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the apparatus of Tengel to include the features of Josephson. One of ordinary skill in the art would have been motivated to do this because an effective means of analyzing multiple criteria.

Referring to claim 29, Tengel discloses requesting application information for the two or more of the plurality of application recipients by presenting a number of questions of number of sets of questions in sequence to said applicant, receiving responses to said questions from said applicant, wherein said application information constitutes or determined from said responses and optimizing said sequence to reduce or minimize said number of questions or sets of questions (see fig. 5).

Referring to claim 30, Tengel discloses an input device for an applicant to input said application to said processor memory and a communication device for communicating or sending said assessments of said application to said applicant (see Fig. 2A).

Claims 32-34 are rejected on the same rationale as claims 28-30 above.

Referring to claim 50, Tengel discloses requesting the application information by presenting a number of questions or a number of sets of questions in sequence to said applicant for the two or more of the plurality of application recipients, said questions comprising groups of

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questions pertaining to respective types of application information and including an introductory question in at least one of said groups of questions to reduce ambiguity in the respective group of questions (see Fig. 5).

Referring to claims 53-55, Tengel discloses refraining from requesting certain application information deemed critical in some or all circumstances (see Fig. 5); forming from the superset of decision criteria for the two or more of the plurality of application recipients from the respective sets of decision criteria (see Fig. 2A, Fig. 5, and claim 28 above); determining what application information is required to assess the application against the superset of decision criteria for the two or more of the plurality of application recipients (see abstract, fig. 2A-3B and 5; col. 6, lines 46-61).

Claims 56-58 are rejected on the same rationale as claims 33, 49, and 50 above.

Claim 61 is rejected on the same rationale as claim 53.

Claim 62 is rejected on the same rationale as claim 28 above.

10. Claims 31, 49, 51, 52, 56, 59, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tengel and Josephson as applied to claim 28 above, and further in view of Hartman et al. U.S. Patent No. 5,960,411 ("Hartman").

As per claims 31, 49, 51, 52, 56, 59, and 60, Tengel teaches a system for processing user loans by receiving and storing lender loan criteria, receiving a borrower application then comparing the application against lender criteria to determine an available loan(s) for the borrower. Specifically, Tengel teaches potential borrowers filling out an application (figure 5). However, Tengel does not explicitly recite presenting to a user a series of forms. Hartman teaches a filling out an application wherein the application comprises multiple electronic forms

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(abstract; figures 1A-2, 8A-C). The Hartman teaching allows a user to complete an application by providing a sequence of forms to a user where the requesting of unnecessary information, and redundant, in these forms is avoided (figures 1C, 3, 4, figures 8A-C; column 2, lines 59-67; column 4, lines 35-58; column 5, lines 8-26; column 7, lines 3-23; column 9, lines 8-53). Specifically, Hartman discloses a method where after completing a first form, the system constructs and presents a second, and subsequent forms containing subsequent information, on the basis of information provided by an applicant in the first form and an applicant sending these forms to a remote system (figure 1A; column 4, lines 44-58; column 9, lines 25-53). Regarding "defects", Hartman teaches a system for detecting "errors", therefore, as this feature is not inherent to a computer and has to be programmed, a decision has to be made as to what is an error. Hence, a "defect" such as not capitalizing a name can be ignored by the system. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Tengel and Hartman in order to ensure efficient and accurate loan form processing by correcting errors in data fields ('411, column 9, lines 35-42) that coincide ('812, figures 3A-B and 5) with all or some lender criteria.

### ***Conclusion***

11. Functional recitation(s) using the word "for" or other functional language (*e.g.* "to reduce" in claim 29, "to receive", "so that" in claim 31, "so as to be" in claim 49) have been considered but are given little patentable weight<sup>3</sup> because they fail to add any structural

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<sup>3</sup> See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that



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limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

12. Applicant is reminded that a wherein clause that merely expresses the intended results does not limit the claim and is not given patentable weight (see MPEP 2111.04).

13. Although the conditional/optional elements have been considered, Applicant is reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See MPEP §2106 II. C: “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Publication NO. 2002/0077970 to Lebda et al.

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although all limitations must be considered, not all limitations are entitled to patentable weight).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and 571-273-6714 for Non-Official /Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/  
Primary Examiner, Art Unit 3685